

REMARKS

The Examiner, in the outstanding Office Action made final, has raised concerns regarding claim 34 and the phrase "less than about", and alleges that the phrase renders claim 34 indefinite. This rejection is not only newly raised in the outstanding Office Action made final, but further does not address the argument presented in the response to the previous non-final Office Action, only simply repeating the rejection.

The Examiner has further cited the U.S. patents 5,991,637 (Mack, II et al.) and 6,252,970 (Poon) and has asserted certain outstanding claims are unpatentable over Mack, II et al. in view of Poon (claims 1-7, 24, 35-43, 55, 56, 61, 63, and 64). Furthermore, the Examiner has cited Mack, II et al. and Poon, further in view of U.S. patent 6,016,347 (Magnasco et al.), as allegedly making unpatentable certain claims (8-23, 25, 26, and 44-54).

The Examiner has also cited Mack, II et al. and Poon, further in view of U.S. patent 4,882,745 (Silver), as allegedly making unpatentable certain claims (claims 27-32 and 57-60). Additionally, the Examiner cites Mack, II et al., Poon, and Silver, further in view of U.S. patent number 5,930,719 (Babitch et al.) as allegedly making unpatentable certain claims (claim 33).

The present Amendment and Request for Reconsideration is provided to fully address the issues identified by the Examiner. This Request for Reconsideration is also presented to identify that new rejections were introduced by the Examiner, providing for a new rejection for claim 34, not further addressing the argument presented for the clarity of claim 34 such that the Examiner's making final the office action unfounded and contrary to 37 C.F.R. 1.136 and MPEP 706.07(a), (d). It is believed that this Amendment and Request for Reconsideration is fully responsive in light of the present prosecution status of the application and accordingly is a bona fide attempt to advance the prosecution of the application.

AMENDMENTS TO THE CLAIMS

The Examiner is respectfully directed to claim 62 as the currently amended claims. Claim 62 is

amended to remove the element "a base" as not having antecedent basis in the claims from which it depends. It is presently asserted that the original disclosure of the application fully supports the amended claim.

EXAMINERS CONCERNS REGARDING 35 U.S.C. SECTION 112, 2ND PARAGRAPH

Concerning Claims 34 and 62 Under 35 U.S.C. Section 112, 2nd Paragraph

Addressing first claim 62, the claim element "a base" has been amended out of the claim as unnecessary, having no antecedent basis, and being fully supported by the original disclosure of the application as amended. Having no other outstanding objections to this claim, the Examiner is respectfully requested to find claim 62 in allowable status.

Now addressing claim 34, the Examiner asserts that the phrase "less than about" is not defined by claim 34, the specification does not provide a standard to ascertain the requisite degree, and one of ordinary skill in the art would not be apprised of the scope of the invention. The Examiner references MPEP 2173.05(b). The rejection of claim 34 is newly presented by the Examiner in the outstanding Office Action. Furthermore, the outstanding Office Action does not address the argument presented against the rejection of the phrase 'less than about' under 35 U.S.C. 112. **Accordingly, the Examiner is requested to withdrawal the finality of the rejection and refund the fees for filing this RCE in accordance with MPEP sections 706.07(a) and 706.07(d).**

Should the Examiner maintain a different understanding of the finality of this rejection and wish to maintain the appropriateness of the outstanding Office Action made final, the undersigned attorney for the assignee respectfully requests the Examiner to contact him to discuss the status. Alternatively, the Office is respectfully requested to refund the fees associated with the filing of the Request for Continued Examination filed herewith.

Addressing the substance of the rejection as it pertains to claim 34, the examiner is first directed to MPEP 2173.05(b)A, describing the appropriateness of the claim limitation. Apart from the previous argument presented below, MPEP 2173.05(b)A cites case law of *Amgen, Inc. v. Chugai Pharmaceutical Co.*, 927 F.2d 1200 (Fed. Cir. 1991). The Court, as described in the MPEP, found that reciting 'at least

about' was indefinite wherein there was close prior art regarding the limitation and there was nothing in the specification, prosecution history, or the prior art to provide indication as to what range of specific activity is covered. However, this and the other case law cited below clearly do not rule out completely the use of 'at least about.'

Addressing the concerns of the Court in *Amgen, Inc.*, citation is made to the written description of the application at paragraphs 33 and 34, wherein features of one embodiment of the invention are described wherein the base comprises a number of features, and wherein the headset is comparably lightweight with respect to previous headsets, **weighing less than seven ounces**, and comprising in some embodiments the various features described in paragraph 34. This support in the specification was one determining factor required by *Amgen, Inc.* Furthermore, each of these features described in the specification are known to one of ordinary skill in the art, and the inclusion of one or more features in the headset, in some embodiments, provides a standard by which one skilled in the art can ascertain the claimed limitation of "less than about seven ounces." Accordingly, the factors defined by the *Amgen, Inc.* Court have been satisfied.

Previous Argument Addressing the 35 U.S.C. 112 Rejection of the limitation 'less than about' Presented to Address the Outstanding Action

In the interest of fully addressing any concerns of the Office, the examiner is directed to claim 34, which recites "wherein said cordless telephone headset system weighs less than about 7 ounces." It is presently urged that the phrase "less than about" is sufficiently definite as disclosed in the specification and under the requirements of 35 U.S.C. section 112, 2nd paragraph.

As the Examiner has astutely pointed out, MPEP section 2173.05(b) provides direction for ascertaining certain claim terminology under 35 U.S.C. 112, 2nd paragraph. As cited within that section, Courts have determined that the fact that claim language, including terms of degree, may not be precise does not automatically render the claim indefinite under the statute. *See Seattle Box Co. v. Industrial Crating & Packing, Inc.*, 731 F.2d 818 (Fed. Cir. 1984). Furthermore, and as the MPEP points out in the cited section, a determination is to be made as to whether the specification provides some standard for measuring that degree.

As but one example, citation is made to the written description of the application at paragraphs 33 and 34, wherein features of one embodiment of the invention are described wherein the base comprises a number of features, and wherein the headset is comparably lightweight with respect to previous headsets, weighing less than seven ounces, and comprising in some embodiments the various features described in paragraph 34. Each of these features are known to one of ordinary skill in the art, and the inclusion of one or more features in the headset, in some embodiments, provides a standard by which one skilled in the art can ascertain the claimed limitation of "less than about seven ounces."

Case law, as cited in the MPEP, further supports the use of the term "about". See *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983); see, also, *Ex Parte Eastwood*, 163 USPQ 316 (Bd. App. 1968). It would appear that where an ascertainable degree or comparison can be made for determining claimed recitation, the language is definite. In the present application, the embodiments of the invention provide for features that may comprise the headset system, such that the weight can be determined to be less than seven ounces.

Should the Examiner have any outstanding concerns regarding the use of the claim language "less than about", the undersigned representative respectfully requests the examiner to notify him of an appropriate opportunity to further discuss the claim recitation in telephone interview.

EXAMINER'S CONCERNS REGARDING THE PRIOR ART

As the Examiner is well aware, the basic requirements of a prima facie case of obviousness are the establishment of the suggestion or motivation to modify the cited references, a reasonable expectation of success, and all claim limitations must be taught or suggested. See, for example, MPEP section 2143 et seq.

All Claim Limitations Not Taught or Suggested

A prima facie showing has not been made at least, but not limited to, wherein Claim 1 recites "a headband having two distal ends" and "a telephone control pivotally connected to one of said distal ends

of said headband” and the Examiner does not establish from any prior art that of the combination of a telephone control pivotally connected to one of said distal ends. The hinge 1102 of Mack does not correspond to a telephone control connection between the telephone control and a distal end of headband as recited in Claim 1. The hinge of Mack is simply a hinge providing a folding function of the headband. The hinge 1102 of Mack does not provide for a telephone control connected, much less pivotally, to one of the distal ends of the headband.

The Examiner asserts in the outstanding Office Action made final that ‘a hinged distal end’ is disclosed in Mack. Office Action March 13, 2006, p. 2. The feature ‘a hinged distal end’ is not a claim element or limitation of Claim 1. Although without asserting that this limitation is read into the claim, but in reference to the limitations of Claim 1, the hinge 1102 is not a connection of a telephone control to the headband or a distal end thereof.

The Poon reference further fails in this regard. Poon does not disclose a telephone control as recited in Claim 1. As identified by the Examiner, Poon discloses a housing (12) and a C-shaped body (30) providing movement of the housing (12). These features of Poon are not “a telephone control” and are not a pivot connection of a telephone control.

Motivation to Combine

Some of the inventive features of the present invention are the features and functionality of the invention regarding telephone control, and in some particular embodiments, pivotal connection of the telephone control not found in the prior art. Such features may not have been considered in the field given at least in part that provision of a telephone control, much less a telephone control having such features as recited in Claim 1 and other claims, would be too complex given mechanical and electrical limitations of traditional telephone control and moveable connections of existing prior art headbands.

One major benefit of the present invention over prior art such as Mack and Poon is the provision of telephone control in a telephone headset system that allows for multiple configurations. An example of use of the invention should prove valuable in understanding the non-obviousness of the invention. The present invention would allow a user to answer or initiate and control a call from the telephone

headset. The telephone headset then can be configured, for example, to facilitate a quick telephone call without the use of the headband and without the telephone configured to a users head. This may be desirable if the user wishes to not mess their hair or otherwise avoid having the unit on their head. The user can simply use the system and control the telephone in a hand-held fashion with the system, picking up, using, and returning the system to the base in hand-held fashion. This may also be beneficial for a quick telephone call in which the user does not want to delay use in putting on the headset. Finally, the functionality provides for the system when worn on the head to have preferred fit to accommodate various head and ear dimensions of the user and left and right ear use.

The prior art, however, as represented in Mack and Poon, establish the actual problems then existing with those technologies. The Mack reference, although disclosing some telephone control in a headset technology, does not allow for the convenient and novel use features of the present invention. The hinge is simply provided to allow the headband to fold to facilitate storage. The Poon reference is not even technology related to telephone control at the headset, wherein a corded connection is provided from headset to the base wherein the telephone control is provided. Nothing in these references show motivation to provide the present inventive features associated with a telephone control on the headset that allows for the functionality previously described.

As argued above, the claim limitations of “a telephone control pivotally connected to one of said distal ends of said headband” are not found in either cited reference. However, the Examiner further asserts, at page 6 of the Office Action made final, that it would have been obvious to “exchange the hinge of Mack with the housing pivot of Poon” to provide better user fit and to convert between first and second user configurations.

A finding of obviousness based upon this rationale is unfounded. The limitation confronted in past attempts with non-telephone controlled headsets was the inclusion of bulky and heavy circuitry associated with telephone control. These efforts in adjustability in non-telephone controlled headset art such as Poon may have actually taught away from adjustability and novel mechanical features of the present invention wherein bulky and heavy circuitry for telephone control were rejected for traditional headset functionality and not equated with adjustability or multiple user configurations.

As Mack would indicate, any thought to adjustability was primarily in the way of non-use configurations, such as storage. The general need for headset adjustability had not been recognized in the field of telephone control headset systems in that it may not have been considered at that time that users of a telephone control headset system would have a need for hand-held configurations, simply relying upon putting the headset on and off in telephone control. Furthermore, the having traditionally bulky and heavy telephone control circuitry may have actually taught away from more functional and adjustable and novel mechanical features of the present invention. Either field of Mack or Poon traditionally did not bridge the gap of telephone control and adjustable features as was provided in the present invention. This novel solution is in part the novelty and non-obviousness of the present invention.

The Examiner is again respectfully requested to consider the invention as a whole in determining the differences between the prior art and the claims, as described and mandated in MPEP 2141.02. The question is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *See Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530 (Fed Cir. 1983). **The Court in the cited case identified that where prior art may have perceived a need for certain functionality, the inventor eliminated the need via the invention.** *See case summary* MPEP 2141.02. “Because the insight was *contrary to the understandings and expectations of the art, the structure effectuating it would not have been obvious* to those skilled in the art. *Stratoflex, Inc.* at 785 (emphasis added).

Accordingly, and at least for the reasons identified above, a prima facie showing of obviousness has not been made by the Office as to all the claims, and in particular, have not established that all claim limitations are taught or suggested by the prior art or establishing a motivation to combine. *In re Royka*, 490 F.2d 981 (C.C.P.A. 1974). It is urged that the cited references do not teach or disclose the invention as claimed in independent claims 1, 35, 37, and 63, and the dependent claims thereof, as argued above and as previously argued in the previous response to the non-final Office Action presented and further argued below.

Previous Argument Addressing the Prior Art Presented to Address the Outstanding Action

The Examiner has alleged that certain claims are made obvious by the Mach, II et al. patent reference in light of the above-cited references and notice taken by the Examiner. It is presently asserted that the claims are novel and nonobviousness in light of the art of record, and accordingly the outstanding rejections based upon such references should be withdrawn.

As the Examiner is aware, the burden of the Examiner in establishing a prima facie case of obviousness includes establishing that all claim limitations are taught or suggested by the prior art. In re Royka, 490 F.2d 981 (C.C.P.A. 1974). It is urged that the cited references do not teach or disclose the invention as claimed in claims 1, 35, 37, and 63, and the dependent claims thereof.

The Examiner has identified that Mack does not teach the telephone control pivotally connected to one of the distal ends of the headband. See outstanding Office Action, Paper No. 10, p. 3. As cited by the Examiner, Mack, II et al. provides description in column 9 of a hinge 1102 provided for storage purposes in non-use applications of the folding headset and for which does not appear to provide pivotal connection of any telephone control. The Examiner asserts that the Poon reference teaches a rotational connection and a C-shaped body (30) that provides 180 degree vertical and horizontal rotation of the housing 12.

However, a prima facie showing of the art teaching or suggesting has not been made as to the claimed recitation of a telephone control pivotally connected as recited in claim 1. Further, the claim limitation of a dial pad pivotally connected as recited in claim 35 has not been taught or suggested. Neither reference identifies a telephone control or a dial pad having the pivotally connected aspects of some embodiments of the present invention and as claimed. The Examiner appears to make the assumption that folding headbands and an earpiece are proper teachings of a telephone control or a dial pad, or even of the pivotal connection features of the present invention. Further, as to claim 35, no teaching has been suggested by the examiner of the recitation of configuration to provide hand-held configuration of the cordless telephone headset. The limitations of method claims 37 and 63, furthermore, have also likewise not been established under the Examiner's prima facie burden, such as the limitations of configuring a telephone control of the cordless telephone headset system to a user configuration.

As the Examiner has not made a prima facie showing of all of the claimed elements of the independent claims, specifically as identifying the teaching or suggestion of the above-described claim recitations in the prior art or through official notice, no further argument need be made as to the non-obviousness of the claimed invention. Furthermore, any further argument presented under these rejections and prior art cannot be made final until a prima facie argument for obviousness has been established by the Examiner.

Alternatively, should a prima facie case of obviousness be presented at a later time, it is presently asserted that the cited references of Mach, II et al. and Poon, and further the additionally cited patents, separately or in combination, do not make obvious at least the features of the invention as recited in the claims 1, 35, 37, and 63.

As the Examiner is well aware, the basic requirements of a prima facie case of obviousness are the establishment of the suggestion or motivation to modify the cited references, a reasonable expectation of success, and all claim limitations must be taught or suggested. *See, for example*, MPEP section 2143 et seq.

No motivation to combine the references, and at the time the invention was made, has been established by the Examiner with respect to the claimed recitations of claims 1, 35, 37, and 63. The Mach, II et al. and Poon references do not suggest the desirability of the claimed invention. Mach, II et al. merely discloses hinged configurations of the headband for storage purposes, while Poon discloses rotation of body (30) to provide left or right configurations for user's head. Neither suggest telephone control nor dial pad features pivotally connected to a distal end of the headband, and as recited in the claims. Furthermore, neither suggest dial pad features configured to provide a hand-held configuration of a cordless telephone headset, and as recited in the claims. Even if it were assumed that the art cited taught all of the claim limitations, the motivation to combine the references and the desirability of the combination is not suggested by the prior art. *See* MPEP 2143.01.

Further with respect to the lack of establishing a prima facie case of obviousness, and although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." *In re Mills*, 916 F.2d 680, 682 (Fed. Cir. 1990). No

suggestion is presented in Mach, II et al. or Poon that would suggest providing pivotal connection of telephone control or dial pad, and as recited in the claims. Connection in Poon is provided for operable head configuration, while hinged configuration in Mach, II et al. is provided for storage purposes. Further, No suggestion is presented in Mach, II et al. or Poon that would suggest hand held configuration, and as recited in the claims. Configurations in Mach, II et al. are directed to head operation or storage while Poon teaches head operation and additionally inward earpiece/receiver configurations.

The Examiner is also respectfully requested to consider the invention as a whole in determining the differences between the prior art and the claims, as described and mandated in MPEP 2141.02. The question is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *See Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530 (Fed Cir. 1983). The Court in the cited case identified that where prior art may have perceived a need for certain functionality, the inventor eliminated the need via the invention. *See case summary* MPEP 2141.02. "Because the insight was contrary to the understandings and expectations of the art, the structure effectuating it would not have been obvious to those skilled in the art. *Stratoflex, Inc.* at 785.

The present invention provides, in some embodiments, for telephone control and dial pad pivotally connected to a distal end of a headband, and as recited in the claims. The present invention also provides configuration to provide a hand-held configuration of the cordless telephone handset. Although folding for storage and rotation for head configuration, and adjustable configuration generally, may have been a perceived need, the Mach II, et al. and Poon references do not show an understanding or expectation of pivotal connection of telephone control, or dial pad, and as claimed, as the present invention provides. Given non-hindsight understanding of the complexity of telephone control at the time of the invention, such functionality may have been contrary to understandings and expectations of art and those in the field. Furthermore, although headset operation may have been perceived, the Mach II, et al. and Poon references do not show an understanding or expectation of hand-held configuration, and as recited in the claims.

Furthermore, it is urged that the cited references do not disclose or suggest the invention as claimed in the dependent claims, and that dependent claims are novel and nonobvious as to the applied

references. As the Examiner is also likely aware, if an independent claim is novel and nonobvious, the claims depending from the independent claims are also nonobvious. See In re Fine, 837 F.2d 1071 (Fed. Cir. 1988). It is urged, therefore, that the dependent claims are novel and nonobvious as to the applied references at least as being dependent from the independent claims, respectively, as presented above, and further in view of the additionally recited limitations. However, as the independent claims are novel and nonobvious as to the applied references cited in the outstanding Office Action for at least the reasons provided above, accordingly, the Applicant respectfully requests the allowance of the independent and dependent claims.

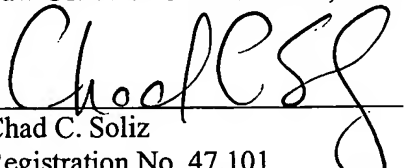
CONCLUSION

Claims 1-64 are pending and claim 62 has been amended. In light of the above amendment and newly presented and previous presented remarks, the Examiner's early reconsideration is earnestly requested.

If any outstanding issues remain with respect to this present amendment and request for reconsideration, the Examiner is respectfully requested to contact the undersigned attorney of record at his earliest convenience to initiate the resolution of any remaining concerns PRIOR TO ANY SUBSEQUENT ACTION. The Examiner is respectfully requested to provide an Examiner Interview to discuss these amendments and remarks and to further facilitate advancement of the application.

Dated this 13 day of September, 2006.

Respectfully submitted,
Law Office of Chad C. Soliz, LLC


Chad C. Soliz
Registration No. 47,101
1401 South Taft Avenue, Suite 202
Loveland, CO 80537
(970) 461-9375